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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,274	09/26/2001	Arthur D. Kranzley	AP33567-070457.1062	8403

21003 7590 07/07/2004

BAKER & BOTTS
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,274

Applicant(s)

KRANZLEY ET AL.

Examiner

Bradley Bayat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/28/03; 6/9/03
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claims 1-5 are presented for examination on the merits.

Priority

Acknowledgment is made of applicant's claim of domestic priority under Provisional Application No. 60/235,738, filed on September 27, 2000.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson, Jr.,

U.S. Patent 6,078,888.

As per the following claims, Johnson, Jr. discloses:

1. A method for conducting a financial transaction with a merchant by a consumer over a communication network and involving a payment network having an issuer for authorizing said transaction based on standard authorization criteria including transaction data and based on a positive authentication of said consumer, said method comprising: utilizing one of a plurality of authentication mechanisms for providing said consumer with cardholder authentication data (column 5, lines 39-65); utilizing a universal cardholder authentication field for transmitting to said merchant said cardholder authentication data regardless of the authentication mechanism

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utilized (column 10, lines 10-21); generating an authorization request including said cardholder authentication data (column 5, lines 50-55); forwarding said request over the payment network (column 5, lines 50-56); and verifying by said issuer said authentication data and authorizing said transaction by said issuer based on said positive verification and on said standard criteria (column 8, lines 15-53).

2. The method of claim 1 wherein said payment network includes a merchant's acquirer and further including the steps of passing said authentication field data along with said transaction data to said acquirer and generating by said acquirer said authorization request (figure 5 and associated text).
3. The method of claim 2 wherein said authentication data comprises at least one of digital certificate serial numbers, digital signatures, application cryptograms and passwords established through at least one of a digital wallet server and smart card (column 4, lines 4-48).
4. The method of claim 3 wherein said consumer utilizes an account number for said transaction and said account number has an associated expiration date and an associated available credit line and wherein said standard authorization criteria comprises an evaluation of said expiration date and said available credit (column 4, lines 4-25; figure 13b and associated text).
5. The method of claim 4 wherein said universal cardholder authentication field is automatically populated with said cardholder authentication data (column 8, lines 5-53).

Claims 1-5 are further rejected under 35 U.S.C. 102(e) as being anticipated by Hogan et al., U.S. Application 2002/0116341 A1.

As per the following claims, Hogan et al. discloses:

1. A method for conducting a financial transaction with a merchant by a consumer over a communication network and involving a payment network having an issuer for authorizing said transaction based on standard authorization criteria including transaction data and based on a positive authentication of said consumer, said method comprising: utilizing one of a plurality of authentication mechanisms for providing said consumer with cardholder authentication data; utilizing a universal cardholder authentication field for transmitting to said merchant said cardholder authentication data regardless of the authentication mechanism utilized; generating an authorization request including said cardholder authentication data; forwarding said request over the payment network; and verifying by said issuer said authentication data and authorizing said transaction by said issuer based on said positive verification and on said standard criteria (§36-41)).
2. The method of claim 1 wherein said payment network includes a merchant's acquirer and further including the steps of passing said authentication field data along with said transaction data to said acquirer and generating by said acquirer said authorization request (§42-44).
3. The method of claim 2 wherein said authentication data comprises at least one of digital certificate serial numbers, digital signatures, application cryptograms and passwords established

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through at least one of a digital wallet server and smart card (§57-64).

4. The method of claim 3 wherein said consumer utilizes an account number for said transaction and said account number has an associated expiration date and an associated available credit line and wherein said standard authorization criteria comprises an evaluation of said expiration date and said available credit (§178-184).

5. The method of claim 4 wherein said universal cardholder authentication field is automatically populated with said cardholder authentication data (§224, 279, 281).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Conclusion

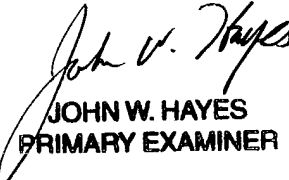
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached on Tuesday-Friday during normal business hours.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bbb


JOHN W. HAYES
PRIMARY EXAMINER